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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,208	02/13/2004	Frederico G. Jaekel	076029-0303290	2479
909	7590	12/16/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			LUBY, MATTHEW D	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	

3611

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/777,208	Applicant(s) JAEKEL ET AL.	
	Examiner Matt Luby	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 1205.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 35-56 is/are pending in the application.
- 4a) Of the above claim(s) 17-34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47 is/are allowed.
- 6) ☒ Claim(s) 1-7, 35-37, 39-46 and 48-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/18/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

This application contains claims 8-16 and 38 drawn to an invention nonelected with traverse on May 16, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-6, 48, ~~50~~-56 is rejected under 35 U.S.C. 102(b) as being anticipated by Maier (U.S. Patent No. 5,853,187).

Maier discloses a mounting structure (10) bent into a general U-shape (Fig. 2) with end portions and an intermediate portion with a hitch receiver (38) mounted in an opening (40) of the intermediate portion. The end portions have a mounting section with an L-shaped cross-section providing horizontally extending mounting flanges (54, 56) with plural openings (22, 24). An elbow section with a general U-shaped cross-section is provided between the intermediate portion and the end portions (Fig. 2).

Regarding claims 1, 2, 52 and 53, the limitations that the hitch mounting structure is "formed from a substantially tubular body member having a generally rectangular cross-section" is a product-by-process limitation. As written in the MPEP 2113, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698 227 USPQ 964, 966 (CAFC 1985).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maier in view of Westerdale.

Maier discloses a hitch assembly having all elements as claimed, as recited above in detail, except that the intermediate portion has a general V-shape and it has a rectangular cross-section. Westerdale discloses that it is well known to have the intermediate portion have a general V-shape (Fig. 1) in order to permit hitch receiver to protrude low enough that it clears the bumper and end of the vehicle it is attached to

(Fig. 1) and a rectangular cross-section (Fig. 3) in order to provide a stronger load structure than a non-tubular section (the obvious advantage of a tubular frame member over a bent sheet frame member when comparing Westerdale's intermediate portion to that of Maier). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide that the intermediate portion of Maier has a general V-shape, as taught by Westerdale, in order to permit hitch receiver to protrude low enough that it clears the bumper and end of the vehicle it is attached to and to provide an intermediate portion of rectangular cross-section on the Maier assembly, as taught by Westerdale, in order to provide a stronger load structure than a non-tubular section.

Claims 35-36, 41, 42, 44-46 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maier in view of Grice.

Maier discloses a hitch assembly having all elements as claimed rigidly mounted to the vehicle at the end portions, as recited above in detail, except for inner and outer hitch member telescopically mounted for sliding movement, and a reversible electric motor and gear arrangement operable to drive the inner receiver relative to the outer receiver. Grice discloses that it is known in the art to provide a inner hitch mounted inside an outer hitch receiver whereby the two members are telescopically connected via a motor (50) and rack (30) and gear assembly (see especially Fig. 4) and a locking assembly (claim 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the hitch assembly of Maier with motorized inner and outer hitch members as taught by Grice in order to enable a user to more easily mate a towing vehicle with a trailer. Such a modification would have permitted a

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length adjustment of the hitch assembly, thereby facilitating connection of the two vehicles without requiring either vehicle to be moved in its entirety and therefore would have been obvious to one of ordinary skill.

Regarding claim 39, the limitation that the hitch mounting structure is "formed from a substantially tubular body member having a generally rectangular cross-section" is a product-by-process limitation. As written in the MPEP 2113, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698 227 USPQ 964, 966 (CAFC 1985).

Claim 40 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maier in view of Grice, as applied to claim 42 above, and further in view of Westerdale.

The modified Maier invention discloses a hitch assembly having all elements as claimed, as recited above in detail, except that the intermediate portion has a general V-shape and it has a rectangular cross-section. Westerdale discloses that it is well known to have the intermediate portion have a general V-shape (Fig. 1) in order to permit hitch receiver to protrude low enough that it clears the bumper and end of the vehicle it is attached to (Fig. 1) and a rectangular cross-section (Fig. 3) in order to provide a stronger load structure than a non-tubular section (the obvious advantage of a tubular frame member over a bent sheet frame member when comparing Westerdale's

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intermediate portion to that of Maier). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide that the intermediate portion of the modified Maier invention has a general V-shape, as taught by Westerdale, in order to permit hitch receiver to protrude low enough that it clears the bumper and end of the vehicle it is attached to and to provide an intermediate portion of rectangular cross-section on the modified Maier assembly, as taught by Westerdale, in order to provide a stronger load structure than a non-tubular section.

***Allowable Subject Matter***

Claim 47 is allowed.

***Response to Arguments***

Applicant's arguments with respect to claims 1-7, 35-37 and 39-46 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matt Luby whose telephone number is (571) 272-6648. The examiner can normally be reached on Monday-Friday, 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6612. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matt Luby  
Examiner  
Art Unit 3611



LESLEY D. MORRIS  
PATENT EXAMINER  
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ML  
December 6, 2005